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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,241	12/02/2003	Herwig Janssen	00-40374-USC	3525

7590 04/09/2007  
Reed Smith LLP  
2500 One Liberty Place  
1650 Market Street  
Philadelphia, PA 19103-7301

EXAMINER
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LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/726,241	JANSSEN ET AL.	
	Examiner	Art Unit	
	NEIL LEVY	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/22/06.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,8,9,11-23 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8,9,11-23,26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### DETAILED ACTION

**Please indicate in the listing of claims that 75 is cancelled, as per REMARKS.**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***The previous 112 2<sup>nd</sup> is withdrawn due to current amendments; so is the 102 rejection***

#### ***Claim Rejections - 35 USC § 112***

Claims 1,8,9,11-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. CLAIM 14 is to ADDITIONAL solvents; what is the solvent of 1?

The following is a quotation of the first paragraph of 35 U.S.C. 112:  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,8,9,11-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims are now to a solution, inclusive of PVM/MA, which is a polymeric particle, as examiner understands, & thus, is not in solution. Examiner finds no support in the specification for the solution.

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The factors to be considered in determining whether a disclosure meets the enablement requirement of 38 U. S. C. 112, the first paragraph have been described in *re Wands*, 8 USPQ2D 1400 (Fed Cir. 1988). Among these factors are (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims. (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary. When the above factors are weighed, it is the examiner's position that instant disclosure fails to meet the enablement requirement for the following reasons:

- (1) The nature of the invention: claims are to unqualified solutions
- (2) The state of the prior art shows the use of these compounds for specific insecticidal functions.
- (3) The relative skill of those in the art. The relative skill of those in the art is high.
- (4) The predictability or unpredictability of the art. The unpredictability of the art is very high.
- (5) The breadth of the claims. The claims are very broad, as only statements of "solution", absent concentration of specified ingredients are evidenced.
- (6) The amount of direction or guidance presented.  
There are none for the claimed solution of PVM/MA & SPINOSADS
- (7) The presence or absence of working examples. There are none (8) The quantity of experimentation necessary extensive-there is NO basis for one to provide a solution, then effective to control lice.

***Claim Rejections - 35 USC § 103***

Claims 1,8,9, 12,14-19,21-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder 6,063,771 in view of Kassebaum et al - 6,933,318, Vermeer-5653970 & Kang- et al 6106815.

The instant compositions are solutions of particles of PVM/MA; just as in Kang, and as compositions would be obvious to the artisan to practice, whether of a solution, as

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claimed, or a dispersion, as the claim is seen by examiner to provide, or as a composition with particles in it, as kang describes.

### Double Patenting

Claims 1,8,9, 11-23,26 stand rejected on the round of nonstatutory obviousness-type double patenting as being unpatentable over claim1 of U.S. Patent No. 6727228. Although the conflicting claims are not identical, they are not patentably distinct from each other because for reasons of record.

Claims 1,8,9, 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims27, 34,35,38,75 & 76 of copending Application No. 11/238316. Although the conflicting claims are not identical, they are not patentably distinct from each other because 11/238316 anticipates the claims as the methods invoke the instant composition. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1,8,9,11-13,15-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 52,59,60,62-64,66-74 of copending Application No. 10/638452. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods provide the instant compositions, as immediately evident to make.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed 12/22/06 have been fully considered but they are not persuasive. Applicant's arguments are , where rejections are maintained, that Kang is

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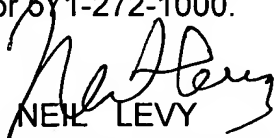
for encapsulated compositions, thus not for solutions. However, the instant is seen as a dispersion, & the references with Kang do provide dispersions, & are combinable

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL LEVY whose telephone number is 571-272-0619.

The examiner can normally be reached on Tuesday-Friday, 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
NEIL LEVY  
Primary Examiner  
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